

**UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF ILLINOIS  
EASTERN DIVISION**

Miyano Machinery USA Inc.,	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. <b>08 C 526</b>
	)	
MiyanoHitec Machinery, Inc., Thomas	)	Hon. Virginia Kendall
("Tom") Miyano, a/k/a Toshiharu Miyano and	)	
Steven Miyano, a/k/a Shigemori Miyano,	)	Magistrate Judge Nolan
Defendants	)	
	)	
<hr style="width: 40%; margin-left: 0;"/>	)	
MiyanoHitec Machinery, Inc., Thomas	)	<b>JURY TRIAL DEMANDED</b>
("Tom") Miyano, a/k/a Toshiharu Miyano and	)	
Steven Miyano, a/k/a Shigemori Miyano,	)	
Counterclaim-Plaintiffs	)	
	)	
v.	)	
	)	
Miyano Machinery USA Inc.	)	
Counterclaim-Defendant	)	
and	)	
Miyano Machinery Inc.,	)	
Third Party Defendant.	)	
	)	

**PLAINTIFF’S RESPONSE TO DEFENDANTS’ MOTION TO COMPEL THE DEPOSITION  
TESTIMONY OF SATORU NAKAGIRI AND TO ENLARGE THE BRIEFING SCHEDULE  
FOR PLAINTIFF’S MOTION FOR PRELIMINARY INJUNCTION**

Plaintiff submits the following response to Defendants’ motion referenced above. Our comments mainly concern Mr. Nakagiri, a Japanese citizen employed in Japan for the past few years by plaintiff’s Japanese parent company Miyano Machinery Inc. (“MMJ”).

Defendants portray plaintiff as hiding until the eleventh hour Mr. Nakagiri’s lack of availability. However, we notified defense counsel on March 14 that Mr. Nakagiri would be available for deposition only before the end of March. We explained why. Despite this forthcoming major change, defendants delayed. Now they blame plaintiff for the fact that Mr.

Nakagiri retired from MMJ.

More specifically, on Friday, March 14, we offered tentative dates (April 9-16) for three (other) depositions in Osaka, Japan. With respect to Mr. Nakagiri, however, we explained, “Mr. Nakagiri will retire from MMJ at the end of March 2008” and “his deposition would have to be taken in Japan before March 31.” Letter of March 14 (Exhibit A, emphasis added). Mr. Nakagiri’s focus on concluding his assignments before leaving MMJ precluded any overseas travel for deposition. For this reason, we advised on March 14 that any deposition of Mr. Nakagiri occur in Japan before the end of March.<sup>1</sup>

We addressed his status again in a teleconference with opposing counsel on Monday, March 17. Our email of March 18 summarized the March 17 discussion and a subsequent email from defendants’ counsel requesting a delay.<sup>2</sup> We reiterated Mr. Nakagiri’s situation as follows:

The MMJ officials that you identified were Messrs. Nakagiri, Ichikawa, It, and Saito. You expressed your hope that Mr. Nakagiri would be available for deposition after his retirement. However I indicated that I have no reason to believe that he would be available during the time period that you were proposing, which initially was for April 9-16. Your afternoon email then advised us that you inadvertently overlooked in your schedule a summary judgment motion in a patent case in Los Angeles on April 10. Accordingly that week would not work for you and you were now requesting to depose the foregoing officials on successive days during the week of April 14.<sup>3</sup>

On Thursday, March 20, the three other MMJ witnesses confirmed their availability for deposition as negotiated. We notified opposing counsel of this and other matters that same day. (March 20 email from L. Alex to G. Baker). We have now reached an oral agreement on the contents of an order for those and are examining a revised draft order from opposing counsel.

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<sup>1</sup> At some time, Defendants learned through sources other than plaintiff’s counsel that Mr. Nakagiri would retire a few days *before* the very end of March 2008. They knew of the exact retirement date before Plaintiff did.

<sup>2</sup> See Exhibit B (March 17 email from G. Baker to L. Alex)

<sup>3</sup> See Exhibit C (March 18 email from L. Alex to G. Baker)

Plaintiff's counsel has diligently sought information about Mr. Nakagiri and today learned the following: as mentioned to the Court in yesterday's 3:30 p.m. conference call, Mr. Nakagiri got married earlier this month. He and his bride are leaving Japan on March 31, 2008 for the Philippines for approximately three months. We are informed that the first part of this will be a honeymoon and the remainder will be language study. He has (they have) no plans to travel to the U.S., Europe, or elsewhere.

Regarding the briefing schedule, Plaintiff has no objection to an adjustment so long as plaintiff has adequate time to submit a reply brief before the scheduled May 9 preliminary injunction hearing.

Respectfully submitted,

Dated: March 26, 2008

s/ Edward Manzo

Edward D. Manzo

Joel Bock

Louis Alex

Jason Smalley

Attorneys for Plaintiff

Edward D. Manzo      I.D. # 03124728  
Joel Bock              I.D. # 00239984  
Louis Alex             I.D. # 06274458  
Jason Smalley         I.D. # 06287426  
COOK, ALEX, McFARRON, MANZO,  
CUMMINGS & MEHLER, LTD.  
200 West Adams Street, Suite 2850  
Chicago, IL 60606  
Phone: (312) 236-8500  
Fax: (312) 236-8176  
emanzo@cookalex.com

**CERTIFICATE OF SERVICE**

The undersigned declares that he/she is over the age of 18 years, not a party to this action, and employed in the County of Cook, by Cook, Alex, McFarron, Manzo, Cummings & Mehler, Ltd., Attorneys at Law, 200 West Adams Street, Suite 2850, Chicago, Illinois 60606. On the date listed below, I caused the filing of the foregoing document with all its attachments and exhibits. I caused the service of these aforementioned documents on the following individuals, as addressed below, by the means indicated, and on the date listed below:

Geoffrey A. Baker  
Geoffrey D. Smith  
DOWELL BAKER, P.C.  
201 Main Street, Suite 710  
Lafayette, Indiana 47901  
(765) 429-4004 telephone  
(765) 429-4114 facsimile  
gabaker@dowellbaker.com

Robert M. Karton  
ROBERT M. KARTON, LTD.  
77 W. Washington St., Suite  
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Vernon W. Francissen  
FRANCISSEN PATENT LAW, P.C.  
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(312)294-9980 telephone  
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Nancy E. Sasamoto  
Steven L. Katz  
MASUDA, FUNAI, EIFERT &  
MITCHELL, LTD.  
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Suite 2500  
Chicago, IL 60601  
312-245-7500 telephone  
nsasamoto@masudafunai.com  
skatz@masudafunai.com

\_\_\_\_ (BY HAND DELIVERY) I caused each such document to be personally delivered by hand to the Chicago, Illinois addressee(s) shown above.

X  (BY ELECTRONIC MEANS) I caused this document to be electronically mailed (emailed) to Vernon W. Francissen, at the address shown above.

X  (BY ELECTRONIC MEANS) I cause each such document to be sent by electronic means through the Electronic Court Filing system to Geoffrey A. Baker, Geoffrey D. Smith and Robert M. Karton, Nancy Sasamoto, and Steven Katz at the addresses shown above, pursuant to LR 5.9.

Executed on March 26, 2008 at Chicago, Illinois.

Signed:

/s Edward Manzo

# Exhibit A



200 West Adams Street, Suite 2850  
Chicago, Illinois 60606  
Phone: 312-236-8500  
Fax: 312-236-8176  
www.cookalex.com  
firm@cookalex.com

March 14, 2008

*Via Email (gabaker@dowellbaker.com)*

Mr. Geoffrey A. Baker  
Dowell Baker, P.C.  
229 Randolph Street  
Oak Park, IL 60302

Re: Miyano Machinery USA Inc. v. MiyanoHitec Machinery Inc. et al.  
Our Reference No.: 2506-0002

Dear Mr. Geoff:

We'll try to answer all your recent questions as well as address additional outstanding issues. To answer your question concerning document production, our client does not have meeting minutes labeled as "#080." We believe we produced the document that you refer to as "080" at MMU0009392.

As for certain designations of confidentiality, the service reports and packing slips contain business sensitive information, including but not limited to the identity of Miyano USA's customers, the specific employees of those customers responsible for service related decision making, corresponding contact information, and sensitive pricing information. We decline to produce these documents without an attorneys' eyes only (AEO) designation to a direct competitor, who is actively seeking to sell machine tools, parts and related services. The same is true for the Time Studies, which we also produced under the AEO designation.

With regard to your request that MMU produce certain executives of Miyano Machinery Inc. (MMJ), for deposition, we reiterate that MMU does not have control over these individuals, and our firm does not currently represent MMJ. However, MMU has been in communication with MMJ and has authorized us to relate the following with regard to Messrs. Nakagiri, Ito, and Ichikawa. This letter is not to be taken as an agreement or acquiescence to make MMJ a party, and MMJ denies that it should be made a party to the suit. There is no obligation on the part of MMJ to participate in the suit and MMU has no authority or ability to compel executives of MMJ to appear.

In regard to the deposition of individuals located outside the U.S., the following must be agreed to in writing: (1) attorneys for all parties must be present at the deposition, and each party will have equal time to question the witness on that day, (2) Defendants will not attempt to serve process or any other documents on the witnesses, either individually or in their capacity as a representative of MMJ; (3) the deposition transcripts will be admissible in any hearing or trial and will be subject to the protective order; (4) MMU as well as MMJ will have a right to independently designate testimony and exhibits as confidential or as attorneys eyes only; (5) a

Mr. Geoffrey A. Baker, Esq.

March 14, 2008

Page 2 of 3

suitable protective must be entered in the case before the commencement of any of these depositions; and (6) if the MMJ executives incur travel expenses (including lodging and meals) for purposes of being deposed, defendants agree to pay half of those expenses.

If defendants agree to the foregoing, depositions could be scheduled as follows. Mr. Nakagiri will retire from MMJ at the end of March 2008. He will not have an opportunity to leave Japan before his retirement. Accordingly, his deposition will have to be taken in Japan before March 31. If you are going to depose any individual in Japan before March 31, then the depositions of the other gentlemen must also be taken in Japan on successive days. If depositions are not taken in Japan, then Mr. Ichikawa could be made available in Chicago on April 9-16.

MMU and MMJ are still checking into the availability of Mr. Saito and are trying to arrange his schedule so that he will also be available between April 9-16. All of the above dates are currently tentative and could be subject to change.

In view of your email and our telephone conversation of today, we are exploring the possibility of conducting depositions in Osaka. Based on our current understanding, the foregoing individuals, especially Mr. Saito, may prefer Osaka to Chicago. We will have MMU attempt to contact the relevant individuals to discuss this option. However, it is currently the weekend in Japan, these individuals are unavailable. We will try to reach them as soon as possible to discuss their availability with respect to Osaka. If the depositions are to be held in Osaka, the above conditions still apply, and it's the defendants responsibility to arrange such depositions and to ensure that they will be in accordance with applicable regulations .

Mr. Nagasawa is generally available in March and April; however, there may be specific dates that he is unavailable due to a conflict. We should be able to schedule a deposition within 1-2 days of those conflicts. You will need a Japanese translator for his deposition.

Mr. Gentaro Kakumae is available for deposition in Chicago from March 20, 2008, through March 31, excluding March 21 and weekends. You will need a Japanese translator for his deposition. To the extent you seek to depose a 30(b)(6) witness on financial matters, we ask that you notice a separate 30(b)(6) deposition and identify with specificity the financial topics of interest. Once we have this information, we may designate Mr. Kakumae as our 30(b)(6) witness.

We provided you on March 4, 2008 with our latest draft of the protective order. We are awaiting your response. We wish to get something on file as soon as possible.

In accordance with our telephone conversation today, we understand that you will endeavor to begin producing documents and materials responsive to our requests on or before March 21. We ask that you advise us within the next ten days as to when you believe your document production will be reasonably complete. We ask for this projected date with the understanding that limited, additional documents and materials that are not otherwise identified through a reasonable investigation may be forthcoming thereafter pursuant to Rule 26(e).

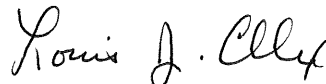
Mr. Geoffrey A. Baker, Esq.

March 14, 2008

Page 3 of 3

The parties have discussed some of the matters identified under Rule 26(f) of the Federal Rules. We wish to complete our discussion of any outstanding Rule 26(f) matters as soon as possible but in no event later than Wednesday, March 19. Please advise us of when you or any of your co-counsel are available to have this discussion by telephone.

Sincerely,

A handwritten signature in cursive script, appearing to read "Louis J. Alex".

Louis J. Alex

cc: Vernon W. Francissen  
Robert M. Karton



# Exhibit B

**Louis Alex**

---

**From:** Geoff Baker [gabaker@dowellbaker.com]  
**Sent:** Monday, March 17, 2008 1:25 PM  
**To:** 'Louis Alex'  
**Cc:** 'Edward Manzo'  
**Subject:** Miyano litigation

Louis,

My apologies, but I forgot one minor item on my schedule, a summary judgment motion in a patent case Los Angeles on April 10. Because of that conflict, we would need to push back the depositions until the following week. We would still like to depose Messrs. Nakagiri, Ito, Saito and Ichikawa on successive days the week of April 14, 2008 in Osaka at the American consulate. We look forward to hearing from you about the scheduling of those depositions at your earliest convenience.

Geoff

Geoffrey A. Baker  
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Exhibit B

3/26/2008

# Exhibit C

**Louis Alex**

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**From:** Louis Alex [lalex@cookalex.com]  
**Sent:** Tuesday, March 18, 2008 9:16 AM  
**To:** 'Geoff Baker'  
**Cc:** 'Edward Manzo'; 'vern@francissenpatentlaw.com'; 'robert@karton.us'; 'Jason Smalley'; 'Joel Bock'  
**Subject:** RE: Miyano litigation

Dear Geoff:

As we discussed yesterday morning, I have passed on to the relevant individuals your requests to depose the MMJ officials noted below according to the schedule that you have proposed.

As I also emphasized in the beginning of our conversation, we do not represent MMJ. MMJ is a separate company and, as we have been advised, will likely retain separate counsel in this matter, the identity of which has not been determined. We hope this decision will happen soon.

The MMJ officials that you identified were Messrs. Nakagiri, Ichikawa, It, and Saito. You expressed your hope that Mr. Nakagiri would be available for deposition after his retirement. However I indicated that I have no reason to believe that he would be available during the time period that you were proposing, which initially was for April 9-16. Your afternoon email then advised us that you inadvertently overlooked in your schedule a summary judgment motion in a patent case in Los Angeles on April 10. Accordingly that week would not work for you and you were now requesting to depose the foregoing officials on successive days during the week of April 14.

As promised, your requests were promptly forwarded to the relevant individuals. Due in part to the 14 hour time difference, we have not received any word back as of yet. As soon as we do hear anything, we will let you know.

Also, regarding Gentaro Kakumae, our March 14 letter notes that Gentaro Kakumae is available for deposition in Chicago from March 20 to March 31. Gentaro is leaving MMU and will likely not be available for deposition after this time period. It is my understanding that Gentaro's status was previously conveyed to your team orally, but wish to confirm this in writing.

Sincerely,

Louis

---

**From:** Geoff Baker [mailto:gabaker@dowellbaker.com]  
**Sent:** Tuesday, March 18, 2008 12:26 AM  
**To:** 'Louis Alex'  
**Cc:** 'Edward Manzo'; vern@francissenpatentlaw.com; robert@karton.us  
**Subject:** Miyano litigation

Louis,

We need to finalize our reservation for the deposition room in the consulate in Osaka. We have confirmed with the consulate that we intend to depose four people on successive days during the week of April 14-18. We will be providing the non-refundable reservation fee and the advance deposit tomorrow. As soon as we hear back from you on the precise dates each witness will be produced, we will need to immediately obtain an order from the Court and have that order certified and provided to the consulate. As we also discussed today, we will need to obtain deposition visas, finalize our translator and also our court reporter.

We are hopeful that we will hear from you on Tuesday, March 18.

Thank you.

Geoff

Exhibit C

3/26/2008

Geoffrey A. Baker  
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